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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------------------|------------------------|
| 10/017,027 | 12/14/2001 | Toshiaki Iizuka | B422-178 | 5437 |
| 26272 7590 09/06/2007 COWAN LIEBOWITZ & LATMAN P.C. JOHN J TORRENTE 1133 AVE OF THE AMERICAS NEW YORK, NY 10036 | | | EXAMINER QUELLETTE, JONATHAN P | |
| | | | ART UNIT 3629 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/017,027

Applicant(s)

IIZUKA, TOSHIAKI

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-18,22 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-18,22 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Claims 1-15, 19-21, 23, and 25 have been cancelled, therefore, Claims 16-18, 22, and 24 are currently pending in application 10/017,027.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 16, 22, and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent Claims 16, 22, and 24 have been amended to disclose a changing means for changing the state of the flag of said function from the enabling state to the disabling state in response to a response of said server apparatus to the prohibition request by said prohibition request means. The newly amended subject matter was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 16-18, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aikens et al. (US 6,216,113).**
6. As per new **independent Claims 16, 22, and 24**, Aikens discloses a client terminal (control method, record medium) in which a software including a plurality of functions is installed and which is capable of communicating with a server apparatus (Fig.1), the terminal comprising: setting means for setting respective flags of said plurality functions into an enabling state and a disabling state; controlling means for controlling usability of the function in accordance with the state of the flag thereof set by said setting means, so as to make the function the flag of which is set in the enabling state, usable and make the function the flag of which is set in the disabling state, unusable (Fig.5, Yes/No to Validity, Validity Control, Exceed Acct. Limit control – are all equivalent forms of setting an enabling/disabling flag for use of functions); payment means for executing payment processing of a price of the function the flag of which is set in the enabling state; prohibition request means for automatically requesting the server apparatus to prohibit the usability of said function (Fig.5, Exceed Acct Limit control – Yes decision automatically determined); and changing means for changing the state of the flag of said function from the enabling state

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to the disabling state in response to a response of said server apparatus to the prohibition request by said prohibition request means (Fig.5, Exceed Acct limit control is equivalent to setting a enabling or disabling flag).

7. Aikens fails to expressly disclose count means for counting a period in which said function the flag of which is set in the enabling state, remains being not used; prohibition request means for automatically requesting the server apparatus to prohibit the usability of said function if said counted period exceeds the predetermined period; and changing means for changing the state of the flag of said function from the enabling state to the disabling state in response to a response of said server apparatus to the prohibition request by said prohibition request means.
8. However, Aikens does disclose the use of billing counters (C5, measuring usage limits; Fig.5, total usage) and the periodic accumulation of billing information (C4 L23-35), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to cancel the account (equivalent to disabling use of function) or to stop replenishing funds in the account (equivalent to stopping charges) if the billing count information (use of functions) was null upon billing information transfer (count of 1 period between last data transfer), for the purpose of increasing system efficiency and decreasing system load, by only supporting active users of the system.
9. As per new Claim 17, Aikens discloses wherein the function is at least one of a scan function, print function, a copy function and a facsimile transmission function (Fig.4, print function).

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10. As per new Claim 18, Aikens discloses icon display means for displaying icons corresponding respectively to said plurality of functions, said icon display means distinctly displays the icons among said plurality of functions in different states in accordance with the enabling state and the disabling state of the flags thereof (C2, L51-65, Icons; Fig.2, Machine status Icon).

Response to Arguments

11. Applicant's arguments filed 6/20/2007 have been fully considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
14. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

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JONATHAN OUELLETTE
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600

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August 30, 2007

A handwritten signature in black ink, appearing to read 'Jonathan Ouellette', is written over the printed name and title.